

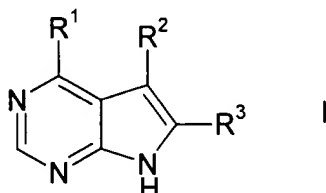
331-332 (CCPA 1978). Restriction of the subject matter of a single claim in a patent application is therefore impermissible because it denies the applicant his right to have the restricted claim examined on the merits. Id. at 131. As the court stated in Weber, "[i]f...a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits." Id.

Restriction of the subject matter of claim 1 is therefore improper because claim 1 is distinct, as required by the second paragraph of 35 U.S.C. §112 and is supported by an enabling disclosure, as required by the first paragraph of 35 U.S.C. §112.

While the Examiner did not state that the Markush groupings of claim 1 were improper, applicants submit, for completeness of response, that the Markush groupings of claim 1, and of claims 2-20, which depend from claim 1, are proper.

The propriety of a Markush grouping is a factual issue to be decided on a case by case basis. In re Harnish, 206 U.S.P.Q. at 305. A Markush grouping is proper if the compounds in the Markush group share a single structural similarity and a community of properties (e.g., a common utility), such that the grouping is not repugnant to the principles of scientific classification. In re Harnish, 206 U.S.P.Q. at 305; Ex parte Brouard, Leroy and Stiot, 201 U.S.P.Q. 538, 540 (P.T.O., Bd. App. 1982). The fact that the compounds in a Markush group may require different fields of search does not render any Markush group improper. Ex parte Brouard, 201 U.S.P.Q. at 540. Also, where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by consideration of the compound as a whole, and does not depend on their being a community of properties among the members of the Markush expression. Ex parte Brouard, 201 U.S.P.Q. at 540; In re Harnish, 206 U.S.P.Q. at 305; M.P.E.P. 706.03(y).

The compounds of claim 1 share a common nucleus that accounts for a very substantial part of their molecular weight and size. This nucleus is depicted by the following structure



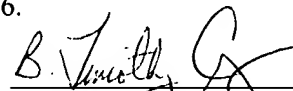
In addition to the physical and chemical properties that are attributable to their structural similarity, the compounds of claim 1 share a common utility. Moreover, they may be prepared by common synthetic routes.

The foregoing statements regarding the structural similarity and community of properties among the compounds of claim 1 is improper and should be withdrawn.

Restriction is not proper in cases where prosecution of the restricted claims in one application would not place a serious burden on the Examiner. M.P.E.P. §803. Prosecution of claim 1 in its entirety, along with the pharmaceutical composition and method claims, would not place a serious burden on the Examiner.

In conclusion, applicants respectfully request that the restriction requirement be withdrawn to allow the subject matter of claims 1-26.

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B. Timothy Creagan  
Attorney for Applicant(s)  
Reg. No. 39,156

Pfizer Inc  
Patent Department  
Eastern Point Road, MS 4159  
Groton, Connecticut 06340  
(860) 715-4546